

HP Docket No.10015559-1

REMARKSDouble Patenting Rejection

Claims 1-16 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over co-pending Application No. 10/001,637.

A terminal disclaimer is submitted herein to overcome this rejection.

Moreover, a 37 CFR 1.132 declaration has been submitted herewith stating that the current application and co-pending Application No. 10/001,637 are commonly owned. Application was filed on October 31, 2001, while the current application was filed on October 29, 2001; thus, they were co-pending at the time of filing. The co-pending applications are commonly owned by Hewlett-Packard.

Rejections under 35 USC 103

Claims 1-19 are rejected under 35 USC 103(a) as being unpatentable over Deardurff et al.

Deardurff et al. teach an ink comprising a colorant and a vehicle. However, Deardurff et al. teach the presence of a surfactant and specifically fails to exemplify the absence of a surfactant. This rejection is respectfully traversed.

While Deardurff et al. teach the optional use of a surfactant, the optimal combination of the specific carbon length ranges of alcohol and diols present in the instant application allows for an ink formulation which is free of surfactants yet still maintains high performance, especially on photo paper. Deardurff et al. fail to recognize, state, or teach the benefits of this combination. In fact, as the Examiner notes, Deardurff et al. does not exemplify an ink formulation without surfactant.

BEST AVAILABLE COPY

HP Docket No.10015559-1

The present claims have been amended to specify that the alcohols are selected in a range of carbon lengths from C5-C10. Deardurff et al. teaches a range from C3-C6. While the ranges do overlap by two carbons, there is nothing in Deardurff et al. which discovers, states, or suggests that by choosing the C5 or higher alcohol in combination with the diol would lead to an ink formulation that is optimized to work without the aid of a surfactant. In fact, Deardurff et al. states that preferred formulations do comprise surfactants.

Moreover, the ink taught in Deardurff et al. allows for the alcohol to be optional and for the organic solvent to be other than a 1,2 diol. Following Deardurff et al. could lead a person skilled in the art to ink formulations very unlike the ones claimed in the present invention. Deardurff et al. teaches ink formulations which comprise ketones and surfactants, but not alcohol. Unlike the present formulations which require the presence of 1,2 diols and alcohol, but does not allow for surfactants and ketones. Thus, even though Deardurff et al. broadly includes a few limited crossover alcohols, diols, and the possibility of no surfactants, they certainly do not lead one skilled in the art to pursue that direction. The current application has developed a formulation that works very well on photo quality paper without the addition of surfactants by very specifically choosing a combination of 1,2 diols and alcohols which are formulated for optimal performance.

Thus based on the foregoing, it is respectfully requested that the rejection of Claims 1-19 under 35 USC 103 be withdrawn.

CONCLUSION

A Terminal Disclaimer and Declaration have been submitted herewith in response to the provisional obvious-type double patenting objection. Moreover, Claims 1 and 17 have been amended to specify the range of alcohols identified by Applicants to formulated inks free of surfactants. With the terminal disclaimer, amendments in place, and the above arguments

BEST AVAILABLE COPY

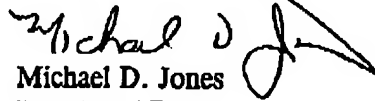
HP Docket No.10015559-1

considered, it is respectfully requested that the rejections to this application be withdrawn and that the applications be placed in condition for allowance.

**AUTHORIZATION TO PAY AND PETITION
FOR THE ACCEPTANCE OF ANY NECESSARY FEES**

If any charges or fees must be paid in connection with the foregoing communication (including but not limited to the payment of an extension fee or issue fees), or if any overpayment is to be refunded in connection with the above-identified application, any such charges or fees, or any such overpayment, may be respectively paid out of, or into, the Deposit Account No. 08-2025 of Hewlett-Packard Company. If any such payment also requires Petition or Extension Request, please construe this authorization to pay as the necessary Petition or Request which is required to accompany the payment.

Respectfully submitted,



Michael D. Jones

Reg. No. 37,157

Attorney for Applicant

Telephone: (858) 655-5973

Date: July 28, 2003
Hewlett-Packard Company
Legal Department, M/S 20BN
P. O. Box 10301
Palo Alto, CA 94303-0890

BEST AVAILABLE COPY